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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,306	08/24/2001	Thomas Lemmons	INTE.14USU1	2562
43997	7590	02/25/2005	EXAMINER	
OPTV/MOFO C/O MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD, SUITE 300 MCLEAN, VA 22102			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/939,306	Applicant(s) LEMMONS ET AL.	
	Examiner Scott E. Jones	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 17-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/24/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the request for continued examination and amendment filed on January 18, 2005 in which applicant amends claims 17, 27, 39, and 44-50, and responds to the claim rejections. Claims 1-8 and 17-50 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 29, 2004 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17, 19-32, and 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat et al. (W.O. 99/00163).

Eilat et al. discloses an interactive game system played over a network between at least two players over a television broadcast. In addition to the players viewing the broadcast, non-players (television) viewers can view the broadcast as well. Eilat et al. additionally discloses:

Regarding Claims 17, 27, 30, 39, and 40:

- launching an interactive game on a video game server (communication network) connected to said television broadcast system that controls play of said interactive game (Abstract, page 5, line 9-page 6, line 11, and page 7, line 7-page 8, line 18);
- embedding first gaming code in a video broadcast stream, said first gaming code generated by said video game server and broadcast to a first set top box (14) at a specific address (player's set top box) in said video broadcast system, said first gaming code comprising a user interface for a first player of said at least two players (Page 6, line 21-page 7, line 7, page 13, lines 4-11, page 24, line 8-page 25, line 4, and figures 1-3);
- embedding second gaming code in a video broadcast stream, said second gaming code generated by said video game server and broadcast to a second set top box (14) at another specific address (player's set top box) in said video broadcast system, said second gaming code comprising a user interface for a second player of said at least two players (Page 6, line 21-page 7, line 7, page 13, lines 4-11, page 24, line 8-page 25, line 4, and figures 1-3);
- selecting at least one of the first and second players for said interactive game based on at least one parameter provided by the first or second players (Page 5, lines 1-4, Page 6, lines 15-20, Page 18, line 19-Page 19, line 5, Page 19, lines 23-29, Page 23, lines 7-13);
- transmitting game control signal, that is generated in response to an input from said first player playing said interactive game, and message data from said first set top box to said video game server (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);
- receiving said game control signal at said video game server (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);

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- generating video images in said video game server in response to said signal (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);
- inserting said video images into said video broadcast stream (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);
- transferring said message data from said video game server to said second set top box (Page 23, lines 7-13); and
- broadcasting said video broadcast stream to a plurality of set top boxes including set top boxes of said at least two players and said at least one non-participating viewer (Page 22, line 24-page 23, line 3).

Regarding Claims 20 and 29:

- combining said video images (first player character-avatar) with second video images (second player character-avatar) and broadcasting combined images to said plurality of set top boxes including said at least one set top box associated with a non-participating viewer (Page 7, lines 18-27, page 9, line 8-page 10, line 4, and page 22, line 24-page 23, line 3).

Regarding Claim 21:

- transmitting said game control signal to said second player (Page 7, lines 18-27, page 9, line 8-page 10, line 4, and page 22, line 24-page 23, line 3).

Regarding Claim 22:

- altering the display produced by said second set top box in response to said game control signal (Page 7, lines 18-27 and page 9, line 8-page 10, line 4).

Regarding Claim 23:

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- generating video images that are an overview (outer view) of said interactive video game (Page 24, lines 8-26). A non-player may see the game from an “outer view”, that is, to include a view of an outside viewer that watches the player as well as the environment in which the player acts.

Regarding Claims 26, 38, and 43:

- said interactive game is a game show game (Page 20, lines 4-9).

Regarding Claim 31:

- said network comprises a back-channel (network connection for communicating player control inputs) in said broadcast system (Page 7, lines 18-27 and page 9, line 8-page 10, line 4).

Regarding Claim 32:

- said network comprises a connection to the Internet (Page 14, lines 14-24).

Regarding Claim 34:

- code that produces a first graphical image of said game in said first set top box (Page 20, lines 10-18). The game show allows the combination of the face of the viewer with the avatar may be made in set top box (14), in which case it would be possible for different viewers in addition to the players to each combine their face with the player’s avatar such that each viewer/player would have a unique view on the display.

Regarding Claim 35:

- code that produces a second graphical image that differs from said first graphical image of said game in said second set top box (Page 20, lines 10-18). The game show allows the combination of the face of the viewer with the avatar may be made in set top box (14), in which case it would be possible for different viewers in addition to the players to each

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combine their face with the player's avatar such that each viewer/player would have a unique view on the display.

Eilat et al. seems to lack explicitly disclosing:

Regarding Claims 17, 27, and 39:

- embedding first markup language code in a video broadcast stream; and
- embedding second markup language code in said video broadcast stream.

Regarding Claims 19 and 28:

- embedding HTML code in said video broadcast stream.

Regarding Claims 24, 36, and 41:

- said interactive game is a sports game.

Regarding Claims 25, 37, and 42:

- said interactive game is a casino game.

Regarding Claims 17, 19, 27, 28, and 39 Eilat et al. discloses embedding first and second gaming code in a video broadcast stream. Furthermore, Eilat et al. discloses the video broadcast stream can be communicated over the "Internet" using Internet protocols. Embedding HTML (hypertext markup language) in a broadcast stream over a network, such as the Internet, was notoriously well known at the time of Applicant's invention. Embedding HTML signals in the broadcast enables the players gaming machine, set top box, and television to incorporate text, graphics, sound, and video associated with the game.

Regarding Claims 24, 25, 36, 37, 41, and 42, Eilat et al. discloses the interactive game is a game between a first and second player competing against each other (Page 8, lines 8-18). It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to

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implement well-known sports or casino games in Eilat et al. One would be motivated to do so because interactive sports and casino games are very entertaining to game players.

5. Claims 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat et al. (W.O. 99/00163) in view of Korilis et al. (U.S. 6,335,744).

Eilat et al. teaches to one having ordinary skill in the art that as discussed above regarding claims 17, 19-32, and 34-43. However, Eilat et al. seems to lack explicitly disclosing:

Regarding Claim 44:

- wherein the registration of at least one of the first and second players is solicited through an advertisement.

Korilis et al., like Eilat et al., teaches of conducting games over a communication network. Therefore, Korilis et al. and Eilat et al. are analogous art. Korilis et al. teaches of a game designed to lure computer users (players) to different websites to play a game. Korilis et al. teaches:

Regarding Claim 44:

- wherein the registration of at least one of the first and second players is solicited through a television advertisement (Column 1, lines 18-32, Column 2, lines 32-45, and Column 3, line 61-Column 4, line 16).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Korilis' registration feature in Eilat et al. One would be motivated to do so because a player would be entertained playing the game and would be more likely to purchase a companies product by viewing the advertisement on the associated website.

6. Claims 18 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat et al. (W.O. 99/00163) in view of (Greenhalgh et al., Creating a live Broadcast from a Virtual Environment-Computer Graphics Proceedings, Annual Conference Series).

Eilat et al. teaches to one having ordinary skill in the art that as discussed above regarding claims 17, 19-32, and 34-43. However, Eilat et al. seems to lack explicitly disclosing:

Regarding Claims 18 and 33:

- displaying player controls in a first portion of a screen viewed by said first player and said video images in a second portion of said screen using said first markup language code.

Greenhalgh et al. teaches of an interactive game presented to conventional passive viewers (television broadcast audience) and to online participants (game players). Therefore, Greenhalgh et al. and Eilat et al. are analogous art. Furthermore, Greenhalgh et al. teaches:

Regarding Claims 18 and 33:

- displaying player controls in a first portion of a screen viewed by said first player and said video images in a second portion of said screen using said first markup language code (Figure 9 and page 380).

It would have been obvious at the time of Applicant's invention to incorporate Greenhalgh's flying vehicle controls and video output in Eilat. One would be motivated to do so because this would enable a player lacking Eilat's "virtual reality kit" to generate player inputs to the game via a conventional personal computer mouse.

Response to Arguments

7. Applicant's arguments filed May 17, 2004 have been fully considered but they are not persuasive with regards to the rejections.

8. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 17, 27, 39, or 44 of this application. Regarding Claims 17, 27, and 39, the

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provisional application lacks support for the newly amended claim limitation, "selecting at least one of the first and second players for said interactive game based on at least one player-defined parameter;". Regarding Claim 44, the provisional application lacks support for the new claim limitation, "wherein the registration of at least one of the first and second players is solicited through an advertisement." Applicant respectfully traverses the Examiner's conclusion and asserts this issue is moot. The examiner agrees the issue is moot with regards to the instant rejection, however, if an intervening reference is required to make a rejection in a subsequent Office Action, Applicant's claim for domestic priority under 35 U.S.C. 119(e) may be revisited.

9. Regarding amended claims 17, 27, 39, and 44, Applicant alleges none of the references cited by the examiner taken alone or in combination disclose the transfer of message data from a first set top box to a video game server and then to a second set top box. The examiner respectfully disagrees. The examiner believes Eilat et al. discloses this feature at page 23, lines 7-13.

10. Regarding claims 17, 27, 39, and 45-50, Applicant alleges Eilat et al. does not disclose the player-defined parameter being provided by the first or second players as currently amended. The examiner agrees this feature may not be explicitly disclosed in Eilat et al., however, the feature is clearly taught in the reference. In the instant application, Applicant cites page 15 for support of the position that a player-defined parameter is provided by the first or second players. One of the player-provided parameters is the player's playing history which is clearly taught as a criterion for a player to be selected in Eliat et al. (page 19, lines 1-5).

11. Regarding the rejection to claim 44 under 35 U.S.C. 103(a) as being unpatentable over Eilat et al. (W.O. 99/00163) in view of Korilis et al. (U.S. 6,335,744), Applicant alleges Korilis discloses a system substantially different from the claimed system and that there is not motivation to combine the references. The examiner respectfully disagrees. As stated above, Korilis et al. teaches of a

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game designed to lure computer users (players) to different websites to play a game. The limitation “wherein the registration of at least one of the first and second players is solicited through a television advertisement” as broadly interpreted by the examiner, can be a player registering at the game website or even an advertiser’s website. Therefore, the limitation “wherein the registration of at least one of the first and second players is solicited through a television advertisement” is not precluded by the Korilis reference. The examiner has provided rationale for combining the references above in the rejection. Furthermore, in response to applicant's argument that there is no motivation to combine the references, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

12. Applicant alleges claims 18-26, 28-38, 40-43, and 45-50 are allowable for at least the same reasons as provided for independent claims 17, 27, 39, and 44. The examiner respectfully disagrees. Please see item No.’s 9-11 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (571) 272-4438. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713

sej

A handwritten signature in black ink, appearing to read "Scott E. Jones", is positioned below the printed name and title.